Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDY D. FELLBAUM
and VOLKER R. ULBRICH

Appeal No. 1998-3176
Application No. 08/388,788

ON BRIEF

Before LIEBERMAN, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12. Claims 13-28 stand withdrawn from further consideration by the examiner as drawn to a non-elected invention. Consequently, claims 13-28 are not before us for review on appeal.[1]

[1] Appellants (brief, page 1) maintain that claims 13-28 are subject to review on appeal as being rejected under the second paragraph of 35 U.S.C. § 112. However, no such rejection of the non-elected claims has been made in this case. Supervisory review of an adverse non-final agency decision with respect to the propriety of a restriction requirement is not by appeal to

BACKGROUND

Appellants' invention relates to an apparatus that is useful in making free-standing diamond film comprising a mandrel having first and second deposition surfaces, the two deposition surfaces distinguishable by possessing different diamond bonding strengths. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. An apparatus for use in making a film of free-standing diamond, comprising:
> a mandrel suitable for use as a substrate in a diamond deposition process having first and second deposition surfaces which are tolerant of high temperature associated with diamond deposition processes, said first surface having a first diamond bonding strength and said second surface having a second diamond bonding strength greater than said first diamond bonding strength.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Smith	4,847,063	Jul. 11, 1989
Chen et al. (Chen)	5,126,207	Jun. 30, 1992
Anno et al. (Anno)	5,204,890	Apr. 20, 1993
Weber et al. (Weber)	5,407,487	Apr. 18, 1995
		(Filed May 05, 1994)

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point

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this Board but by way of petition pursuant to 37 CFR § 1.181.

out and distinctly claim the subject matter which applicants regard as invention. Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Chen. Claims 1 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen. Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Smith. Claims 1, 4-10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anno. Claims 1, 2 and 6-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber.

Rather than reiterating the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer and to appellants' briefs for a complete exposition thereof.

OPINION

We reverse all of the rejections advanced by the examiner for substantially the reasons set forth in appellants' briefs.

Rejection under 35 U.S.C. § 112, second paragraph

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree

of precision and particularity. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner is concerned with alleged ambiguity regarding several words and terms of claim 1 as set forth at page 3 of the answer. However, for reasons set forth in the briefs, the examiner simply has not carried the burden of explaining how the claim language does not set forth the recited apparatus in a manner that would be reasonably understood by one of ordinary skill in the art as interpreted in view of appellants' specification and the prior art. The examiner's comments regarding room temperature at page 6 of the answer suggests that the examiner improperly and selectively tagged particular words and phrases as being indefinite without construing the same in the context of the claimed invention as a whole as it would have been understood by one of ordinary skill in the art. Consequently, the examiner has not established how the appealed claims run afoul of the provisions of the second paragraph of 35 U.S.C. § 112. Thus, we cannot sustain this rejection.

Rejection under 35 U.S.C. § 102

The difficulty we have with the examiner's position regarding the rejection of claim 1 as being anticipated by Chen is that the examiner has not fairly explained how the coated

diamond of Chen reasonably corresponds to the claimed apparatus including a mandrel that has two deposition surfaces with different properties. As noted by appellants in the briefs, each deposition surface of a mandrel suitable for diamond deposition is an exposed surface of that mandrel, not an interior unexposed layer. Here, the examiner does not seem to have taken that basic understanding of the recited limitations of the claimed apparatus into account. Rather, the examiner refers to column 2, lines 30-55 of Chen and suggests that an intermediate layer disclosed therein somehow corresponds to one of the claimed mandrel deposition surfaces. Hence, the examiner's determinations regarding the correspondence of the prior art teachings and the claimed subject matter appear to be premised on an incorrect assessment of what is being claimed.

Accordingly, we will not sustain the examiner's § 102 rejection of claim 1.

Rejections under 35 U.S.C. § 103

In rejecting claims 1 and 5 under § 103(a) over Chen, in rejecting claims 2 and 4 under § 103(a) over Chen and Smith, in rejecting claims 1, 4-10 and 12 under § 103(a) over Anno and in rejecting claims 1, 2 and 6-11 under § 103(a) over Weber, the examiner has not shown how the applied prior art would have

suggested an apparatus comprising a mandrel having two surfaces suitable for diamond deposition as herein claimed. In a rejection under 35 U.S.C. § 103(a), it is basic that all limitations recited in a claim must be considered and given appropriate effect in judging the patentability of that claim against the prior art. See In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974). This, the examiner has failed to do. Consequently, we shall reverse all of the examiner's stated § 103(a) rejections for failure to make out a prima facie case of obviousness for substantially the reasons as set forth in the briefs.

CONCLUSION

The decision of the examiner to reject claims 1-12 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as invention, to reject claim 1 under 35 U.S.C. § 102(b) as being anticipated by Chen, to reject claims 1 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Chen, to reject claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Smith, to reject claims 1, 4-10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Anno and to reject claims 1, 2 and 6-11 under 35 U.S.C. § 103(a) as being unpatentable over Weber is reversed.

REVERSED

PAUL LIEBERMAN Administrative Patent Judge	)
PETER F. KRATZ Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)

PFK/sld

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

APJ KRATZ

APJ

APJ

DECISION: **ED**

Prepared By:

DRAFT TYPED: 27 Jun 03

FINAL TYPED: